

## **REMARKS**

The Applicant thanks the Examiner for the Office Action of August 5, 2008. The above amendments and the following remarks together with the attached Request for Continued Examination (RCE) are submitted as a full and complete response thereto.

### **1. Summary of Case Status**

Claims 1 – 20 were pending in the subject application.

Claims 1 – 12, 13 and 15 - 20 have been rejected under 35 U.S.C. §103(a) as being obvious given U.S. Patent No. 6,234,677 of Mogil in view of U.S. Patent No. 5,501,338 of Preston;

Claims 1 – 11, 16, 17, 19 and 20 are also rejected as being obvious under 35 U.S.C. §103(a) given U.S. Patent No. 6,234,677 of Mogil in light of U.S. Patent No. 5,403,095 of Melk;

Claim 14 has been rejected under 35 U.S.C. §103(a) as being obvious given U.S. Patent No. 6,234,677 of Mogil in light of U.S. Patent No. 5,403,095 of Melk and further in light of U.S. Patent No. 5,020,921 of Beales;

Claims 3 and 4 are additionally rejected under 35 U.S.C. §103(a) as being obvious given U.S. Patent No. 6,234,677 of Mogil in view of no less than five combined references, namely U.S. Patent No. 5,501,338 of Preston; U.S. Patent Publication No. 2003/0139169 of Arreazola; U.S. Patent No. 6,305,185 of Sloan; U.S. Patent No. 6,216,488 of Rucker; and U.S. Patent No. 5,979,175 of Ellison;

Claims 3 and 4 are still further rejected under 35 U.S.C. §103(a) as being obvious given U.S. Patent No. 6,234,677 of Mogil in view of no less than five differently combined references, namely U.S. Patent No. 5,403,095 of Melk; U.S. Patent Publication No. 2003/0139169 of Arreazola; U.S. Patent No. 6,305,185 of Sloan; U.S. Patent No. 6,216,488 of Rucker; and U.S. Patent No. 5,979,175 of Ellison;

The Applicant respectfully traverses all of these rejections, and requests that they be reconsidered and withdrawn.

**(2) The Law**

The Applicant repeats the statements of law previously made in this matter.

**(3) Rejections Under 35 U.S.C. §103(a)**

**U.S. Patent No. 6,234,677 of Mogil Teaches Away**

Each rejection in the Office Action, made 'Final', of August 5, 2008 relies on U.S. Patent No. 6,234,677 of Mogil, as the principal reference. As argued in the previous response of May 5, 2008, and in the response of October 6, 2008, the Applicant again respectfully submits that Mogil '677 teaches away from the presently claimed invention.

As noted above, a *prima facie* case of obviousness may always be rebutted by showing that the art teaches away from the claimed invention in any material respect. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). The Mogil '677 reference teaches away from the current invention in at least one material way: namely collapsibility of the containers.

Every claim of Mogil '677 recites a "collapsible" container. Mogil '677 also teaches that when the container is not in use "the entire assembly can be folded into a collapsed position for storage" ('677 abstract). Figures 20, 21, 27 and 28 clearly illustrate a container that can be collapsed and retained in a collapsed configuration for storage. That is, the container is movable between (a) an expanded condition (Figures 15- 19 of Mogil '677) and (b) a neatly folded condition (Figures 20, 21, 27 – 31). The rigid liner of the present invention is just that: "rigid", *i.e.*, not collapsible. It would prevent the cooler from being collapsed. Further, in addition to teaching away, since the use of a rigid liner would destroy the functionality of the Mogil reference, the rejection cannot stand given *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)) (at page 13).

The Applicant therefore respectfully requests that all rejections under 35 U.S.C. §103(a) that rely on U.S. Patent No. 6,237,677 be reconsidered and withdrawn.

**Teaching Away – Mogil '677 – Reply Commentary in Office Action**

The Office Action suggests that:

"Examiner does not find this argument persuasive, as the benefits of adding a rigid liner would be especially apparent in a container which had otherwise collapsible walls, by providing additional support to the walls, and thus preventing damage to the items held in the interior. With regards to the arguments that adding a rigid liner would no longer allow the container to be collapsible, examiner notes that both rigid liners (Preston and Melk) are removable."

### **Destruction of Function: “Benefit” Rationale Incorrectly Inferred**

The teaching in the principal reference is that it is desirable that the cooler be collapsible.

As such, the introduction of a rigid liner to the apparatus of the principal reference is not a benefit. On the contrary, it is a destruction of function, contrary to *In re Gordon*, previously cited. The Applicant respectfully submits that where there is destruction of function, it is not a matter of whether the argument is considered “persuasive” or not. As a matter of long settled law, obviousness cannot be established where the proposed combination or modification results in the destruction of function of either reference.

### **Inconsistent Interpretation – Removability of Melk and Preston Liners**

The rationale now said to support the rejection is that it is obvious to add a rigid liner to make the container portion non-collapsible as recited in the claim, but that since the liner is removable the collapsibility taught by the principal reference remains unimpaired, because the apparatus would still be collapsible, even though it is deemed non-collapsible to support the rejection.

The Applicant respectfully submits that the self-contradictory nature of this rejection is plain on its face. Consistency of interpretation is a requirement of the law. Either the article has a rigid liner for the purposes of interpretation of the claim language, or it does not. If the rejection relies on the presence of a feature X for establishing the recited features of a claim, the rejection cannot at the same time rely on the absence of feature X as well.

The Applicant requests reconsideration and withdrawal of the rejections.

### **Burden on Commissioner to Articulate Clear Reason Supporting Rejection**

The Applicant respectfully submits that (a) the Commissioner bears the burden of establishing grounds for rejection; and (b) nothing in either of the Office Actions provides an objective showing that so much as a single person of any level of skill in the art would make the interpretations of the references put forth as bases for rejection, that requires the adoption of a rigid liner for one part of the container, and the not-adoption of the very same liner for the other part, when any decision to make such a choice is entirely arbitrary. There is no objective support in any cited piece of art or in any logical reason presented in the Office Actions for this “one, but not the other” modification or combination. As such, the Commissioner has not established a basis for the rejection according to law.

### **Rejection of Claims 1-12, 13 and 15-20: The Preston Reference**

The Office Action rejected claims 1-12, 13 and 15-20 under 35 U.S.C. §103(a) as being unpatentable over Mogil '677 in view of U.S. Patent No. 5,501,338 of Preston.

The Applicant reiterates its arguments filed on May 5, 2008 and October 6, 2008 in respect of these rejections, and again respectfully requests that the rejection of independent claims 1 and 16 and the related rejections of dependent claims 2-12, 13, 15 and 17-20 be reconsidered and withdrawn.

### **Rejection of Claims 1-12, 13 and 15-20: The Melk Reference**

Regarding the rejections of claims 1-12, 13 and 15-20 as being unpatentable over Mogil '677 in view of U.S. Patent No. 5,403,095 of Melk, the Applicant respectfully submits that these rejections suffer from the same problems as the rejections based on the

combination of Mogil '677 and Preston.

In combining the teachings of Mogil '677 with the teachings of Melk to arrive at the claimed invention, the rejection merely substitutes a plastic bucket taught by Preston with a plastic bucket taught by Melk. Accordingly, for reasons analogous to those explained above in reference to Preston, the Applicant respectfully submits that:

(a) the Office Actions have failed to articulate any objective logical reason why a person skilled in the art would insert a rigid container into an insulated container that is operable to collapse for storage, thereby destroying the functionality of the latter;

(b) the Mogil '677 reference teaches away from the non-collapsibility that would result from incorporation of the Melk bucket; contrary to *In re Geisler*, supra; and

(c) incorporation of the rigid bucket of Melk would destroy the collapsible functionality of Mogil '677, contrary to *In re Gordon*, supra.

For these reasons, the Applicant respectfully requests that the rejection of independent claims 1 and 16 and the related rejections of dependent claims 2-12, 13, 15 and 17-20 be reconsidered and withdrawn.

#### **Rejection of Claim 14: The Beales Reference**

Claim 14 has been rejected on the basis of a combination of the '677 Mogil in view of '095 Melk and further in view of U.S. Patent No. 5,020,921 of Beales. The Applicant repeats and incorporates by reference the previous argument made in respect of this rejection.

#### **Rejection of Claims 3 and 4: The Rigid Cooler References**

The Applicant repeats and incorporates by reference the previous argument made in respect of these rejections.

#### **4. Amendments to the Claims**

Claim 1 has been amended explicitly to state that the first portion is non-collapsible, and that the second portion is collapsible to underscore the teaching away of the cited principal reference. In a similar vein, claim 1 has been amended to indicate that the second portion is unlike the first portion in having releasable securements. The point, again, is that the principal reference teaches collapsible compartments. The claimed invention requires that one of the compartments be non-collapsible, directly contrary to the teaching of the principal reference.

Claim 16 has been amended to similar effect.

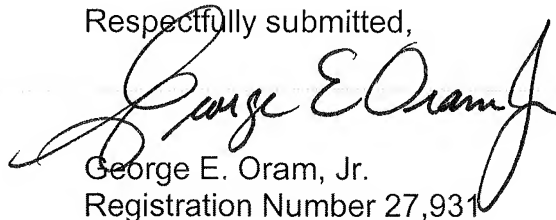
Claim 5 has been amended to clarify that the liner of the second portion is collapsible.

## Conclusion

The Applicant respectfully submits that all of the claims presently pending in this case are in condition for allowance. The Applicant therefore respectfully requests early and favourable disposition of this matter. If the Examiner believes that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below to schedule a personal or telephone interview to discuss any remaining issues.

In the event that this paper is not considered to be timely filed, an appropriate extension of time is requested. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to Counsel's Deposit Account No. 01-2300, referencing Attorney Docket Number 024643-00015.

Respectfully submitted,

A handwritten signature in black ink, reading "George E. Oram, Jr.", written in a cursive style.

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